

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/516,978

Applicants: Messe et al.

Examiner: Not Assigned

Art Unit: Not Assigned

Title: ACTINIC RADIATION CURABLE COMPOSITIONS AND THEIR USE §
August 11, 2005

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RECEIVED

27 JAN 2006

Legal Staff
International Division

AFFIDAVIT IN SUPPORT OF APPLICANTS'
PETITION FOR FILING UNDER 37 C.F.R. 1.47

I, BRITT VAN ESSCHE, declare that I make this affidavit in support of Applicants' Petition for filing under 37 C.F.R. 1.47.

1. I am Senior IP Formalities Administrator of Huntsman (Europe) BVBA;
2. On information and belief, Messe Laurence Josette and Hayes Barrie James are joint inventors of the invention disclosed and claimed in the above-identified application.
3. On or about June 23, 2005, Huntsman LLC received from the United States Patent and Trademark Office a Notification of Missing Requirements Under 35 U.S.C. 371 in The United States Designated/Elected Office mailed June 17, 2005 requesting an Oath or Declaration be furnished for the above-identified U.S. Patent Application Serial No. 10/516,978 to complete the requirements for acceptance under 35 U.S.C. 371 (Exhibit 1).
4. The subject application was prepared by patent counsel and was forwarded to me mid November 2004. I prepared a cover letter attaching a copy of the application papers, including a copy of the specification comprising description, claims, abstract and drawing; assignment and declaration for the above-identified US Patent Application to be mailed for execution by the inventor Hayes Barrie James. As the inventor left the company, the custom

within our office is, to give the inventor a telephone call informing him of the mailing of the assignment and declaration and requesting him to sign and return the assignment and declaration for the above-identified US Patent Application. After a few attempts, I was able to reach Barrie Hayes by telephone on February 1, 2005. Barrie Hayes said he was very happy to hear he was mentioned as inventor. He wanted to discuss some compensation for this, so I advised him to get in touch with Ranjana Patel, our patent facilitator at the Huntsman Duxford site where he used to be employed.

5. I forwarded a Declaration and Assignment for the subject application to Barry Hayes for his review and execution by DHL Worldwide Express dated February 9, 2005, airway bill no. 9604900325, signed for receipt by B. Hayes on February 10, 2005 at 16.42h. ((Exhibit 2 – attachment cover letter). On February 15, 2005 I received a telephone call from Barrie Hayes, confirming his conversation with Ranjana Patel of that day on the subject of further remuneration and the receipt of the Declaration and Assignment sent by me. Mr. Hayes explained he was going to send a letter to me clarifying his point of view.

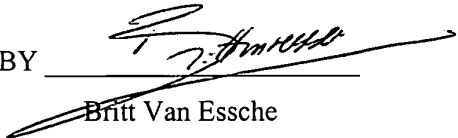
6. On February 24, 2005 I received a letter from Barrie Hayes, dated February 20, 2005 (Exhibit 3) outlining his situation relative to the patent. Mr. Hayes concluded he had not been treated correctly, however, unintentionally, by Huntsman. At the time, he should have been able to negotiate a commercial arrangement which according to him would almost certainly had been for a cash payment and a royalty on sales. So he suggested receiving “a reasonable and final settlement”.

7. As Barrie Hayes was a paid consultant at the time the invention was made, and no trace of agreement for further remuneration has been found, Huntsman refuses to pay again Mr. Hayes.

8. To date, on information and belief, Mr. Barrie Hayes remains unwilling to execute the Inventor’s Declaration and Assignment for the subject application.

9. I declare further that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

BY


Britt Van Essche

Date

11 AUG. 2005



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

HAM 830006

| | | |
|---|---|---------------------------------|
| U.S. APPLICATION NUMBER NO. 10/516,978 | FIRST NAMED APPLICANT Laurence Josette Messe | ATTY. DOCKET NO. 128905-1004 |
|---|---|---------------------------------|

INTERNATIONAL APPLICATION NO.

PCT/QB03/02410

I.A. FILING DATE

PRIORITY DATE

06/04/2003

06/06/2002

Russell R Stolle
 Huntsman Advanced Materials America Inc
 P O Box 15730
 Austin, TX 78761-5730

PATENT & LICENSING DEPT
 AUSTIN

JUN 23 2005

☐ FRG ☐ JPN ☐ MCV
☐ ROG ☐ AGT

CONFIRMATION NO. 6873

371 FORMALITIES LETTER

OC000000016310282

Date Mailed: 06/17/2005

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 12/03/2004
- Copy of the International Search Report filed on 12/03/2004
- Preliminary Amendments filed on 12/03/2004
- Information Disclosure Statements filed on 12/03/2004
- Request for Immediate Examination filed on 12/03/2004
- U.S. Basic National Fees filed on 12/03/2004
- Priority Documents filed on 12/03/2004

RESPONSE DUE:

Aug 17, 2005

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date.
- \$130 Surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492(e)) is required.

SUMMARY OF FEES DUE:

Total additional fees required for this application is \$130 for a Large Entity:

- \$130 Late oath or declaration Surcharge.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

RECEIVED TIME 24 JUN. 23:51

PRINT TIME 24 JUN. 23:52

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.138(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

PAULETTE R KIDWELL

Telephone: (703) 308-9140 EXT 216

PART 1 - ATTORNEY/APPLICANT COPY

| U.S. APPLICATION NUMBER NO. | INTERNATIONAL APPLICATION NO. | ATTY. DOCKET NO. |
|-----------------------------|-------------------------------|------------------|
| 10/516,978 | PCT/GB03/02410 | 128905-1004 |

FORM PCT/DO/EQ/905 (371 Formalities Notice)

RECEIVED TIME 24. JUN. 23:51

PRINT TIME 24. JUN. 23:52

Exhibit 2

HUNTSMAN

Intellectual Property Department
Tel. +32 (0)2 758 9782 • Fax +32 (0)2 758 90 75

Mr. Barry Hayes
Westlands,
33 High Street, Eversden
Cambridgeshire CB3 7HE
Great Britain

09 February 2005

Re: International Application no. PCT/GB03/02410 – National phase
Title: ACTINIC RADIATION CURABLE COMPOSITIONS AND THEIR USE
Our ref. : HAM 830006/WO

Dear Mr HAYES

You are named as inventor on the invention: ACTINIC RADIATION CURABLE COMPOSITIONS AND THEIR USE. We have now filed this application in the US and Canada. This application corresponds to International application PCT/GB03/02410 filed on 04 June 2003. You can find the international application on this link:

<http://ofi.epoline.org/view/GetPdfPage?dosnum=&pubnum=WO03104296&NPL=N&objectId=EGZ7PPVLDHEPLEI&firstPage=1&lastPage=47&lang=EN&step=2>

In order to comply with the filing formalities, a declaration and assignment needs to be filed in the US. An Assignment needs to be filed in Canada. The declaration for the US and the assignment for Canada only require a simple signature and date, the assignment for the US must be signed, dated and notarised by notary public. The fee for the Notary Public is at the expenses of Huntsman Advanced Materials (UK) Ltd., Att. Mrs R Patel, Ickleton Road, Duxford, Cambridge CB2 4QA, UK.

We would appreciate if you could sign these documents and return them to my attention at the address below.

If you have any questions, please do not hesitate to contact me.

Yours faithfully



Britt Van Essche
IP Formalities Administrator
Huntsman (Europe) BVBA

Encl.:

- 1 assignment US
- 1 declaration US
- 1 assignment CA

O:\My Documents\IP Formalities 2005\Patents AdMat\inventor\wholeftcompany\tr barry hayes.doc/bve2005

HUNTSMAN (EUROPE) BVBA
Everslaan 45, B-3078 Everberg, Belgium, Telephone (0)2 758 92 11, Telefax (0)2 759 55 01
BTW - BE - 0468.807.829, RPR Leuven

EV002

ASSIGNMENT

FOR good and valuable consideration, the receipt of which is hereby acknowledged, We:

MESSE Laurence Josette

address: 49 Pilgrim Close, Great Chesterford, Essex CB10 1QC, UK

HAYES Barrie James

address: Westlands, 33 High Street, Eversden, Cambridgeshire CB3 7HE, Great Britain

hereby sell and assign to HUNTSMAN ADVANCED MATERIALS AMERICAS INC, a corporation of the State of Delaware, having a place of business at 500 Huntsman Way, Salt Lake City, Utah 84108 U.S.A., its successors and assigns, the entire right, title and interest in and to our invention relating to

"Actinic Radiation Curable Compositions and their Use"

(D#HAM 830006),

in and for the territory of the United States of America, and we hereby assign to HUNTSMAN ADVANCED MATERIALS AMERICAS INC. the application for United States Letters Patent that was filed on June 04, 2003 as Application Serial Number PCT/GB2003/002410, and all United States patents granted therefor and all divisions, reissues, continuations and extensions thereof, and we hereby sell and assign to the HUNTSMAN ADVANCED MATERIALS AMERICAS INC., its successors and assigns, the entire right, title and interest in and to the invention in and for all countries foreign to the United States of America, and we hereby covenant that we have full right so to do, and we agree that we will sign all lawful papers, execute all divisional, continuation and reissue applications, authorizations, assignments, and application papers, make all rightful declarations, affirmations, and oaths and generally do everything possible to aid HUNTSMAN ADVANCED MATERIALS AMERICAS INC., its successors, assigns and nominees, to obtain and enforce proper protection for the invention in all countries throughout the world.

Inventors' Signatures (Full Names):

Laurence Josette

MESSE

Date

Barrie James

HAYES

Date

COUNTRY of GREAT BRITAIN

ss:

CITY of Great Chesterford

On this _____ day of _____ 2004, before me personally appeared
Laurence Josette MESSE to me known and known to me to be the individual who executed the foregoing
instrument, and acknowledged that he executed the same.

(SEAL)

Notary Public

COUNTRY of GREAT BRITAIN

ss:

CITY of Eversden

On this _____ day of _____ 2004, before me personally appeared
Barrie James HAYES to me known and known to me to be the individual who executed the foregoing
instrument, and acknowledged that he executed the same.

(SEAL)

Notary Public

DECLARATION FOR PATENT APPLICATION

As an undersigned inventor, I hereby declare that:

My residence, post office address and country of citizenship are as stated directly below my name.

I believe (check one) ☐ I am the original, first and sole inventor
☒ I am a joint inventor and the below named inventors are the original and first inventors

of the subject matter which is claimed and for which a patent is sought on the invention entitled
ACTINIC RADIATION CURABLE COMPOSITIONS AND THEIR USE;
HAM 830006

the specification of which

(check one) ☐ is attached hereto.

☒ was filed on 04 June 2003

as Application Serial No. PCT/GB2003/002410

and was amended on _____ (if applicable).

I further declare that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the United States Patent and Trademark Office (hereinafter "the Office") all information known to me to be material to patentability of the subject matter which is claimed as defined in 37 C.F.R. §1.56.

I hereby claim provisional and/or foreign priority benefits under 35 U.S.C. §119 of any provisional and/or foreign application(s) for patent or inventor's certificate indicated below and have also identified below any provisional and/or foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed, all of which have been filed by me or by the assignee.

| Provisional/Prior Foreign Application(s) | | | Priority Claimed | |
|--|-----------|----------------------|-------------------------------------|--------------------------|
| Number | Country | Day/Month/Year Filed | Yes | No |
| <u>0212977.3</u> | <u>GB</u> | <u>06 june 2002</u> | <input checked="" type="checkbox"/> | <input type="checkbox"/> |
| _____ | _____ | _____ | <input type="checkbox"/> | <input type="checkbox"/> |
| _____ | _____ | _____ | <input type="checkbox"/> | <input type="checkbox"/> |

I hereby claim the benefit under 35 U.S.C. §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of 35 U.S.C. §112, I

acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56, which became available between the filing date of the prior application and the national or PCT international filing date of this application:

| Application Serial No. | Filing Date | Status (patented, pending, abandoned) |
|------------------------|-------------|---------------------------------------|
| _____ | _____ | _____ |
| _____ | _____ | _____ |

Address all telephone calls to Russ R. Stolle at telephone number (713) 235-6624.

Address all correspondence to:

Legal Department
HUNTSMAN LLC
Post Office Box 15730
Austin, TX 78761
(512) 483-0170
(512) 483-0933 (Fax)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and may jeopardize the validity of the application or any patent issued thereon.

Full name of first inventor Laurence Josette MESSE

Inventor's Signature _____ Date _____

Residence 49 Pilgrim Close, Great Chesterford, Essex CB10 1QC, Great Britain

Citizenship FR

Post Office Address Same as above

Full name of second joint inventor, if any Barrie James HAYES

Inventor's Signature _____ Date _____

Residence Westlands, 33 High street, Eversden, Cambridgeshire CB3 7HE, Great Britain

Citizenship GB

Post Office Address Same as above

ASSIGNMENT

Whereas I/we

1. MESSE Laurence Josette
2. HAYES Barrie James

of

1. 49 Pilgrim Close, Great Chesterford, Essex CB10 1QC, GB
2. Westlands, 33 High Street, Eversden, Cambridgeshire CB3 7HE, GB

have made an invention relating to

ACTINIC RADIATION CURABLE COMPOSITIONS AND THEIR USE

as fully set forth and described in the specification submitted for the obtention of a patent in CANADA

AND WHEREAS, HUNTSMAN ADVANCED MATERIALS (SWITZERLAND) GmbH a limited liability company formed under the laws of Basel, Switzerland and having its address for correspondence at
Klybeckstrasse 200
4057 Basel
Switzerland

is desirous of acquiring in and for CANADA, the entire right, title and interest in and to the said invention and Letters Patent of CANADA to be obtained therefore.

NOW, THEREFORE, in consideration of the premises and other valid consideration, I/We have sold, assigned and transferred and by these presents do hereby sell, assign and transfer unto the said HUNTSMAN ADVANCED MATERIALS (SWITZERLAND) GmbH the entire right, title and interest in and to the said invention in and for CANADA, and Letters Patent for CANADA which may be granted therefore, the same to be held and enjoyed by the said HUNTSMAN ADVANCED MATERIALS (SWITZERLAND) GmbH its successors, assigns and legal granted, as fully and entirely as the same would have been held and enjoyed by me/us if this assignment and sale had not been made; and I/We hereby request the Commissioner of patents to issue the Patent to HUNTSMAN ADVANCED MATERIALS (SWITZERLAND) GmbH in accordance with this assignment.

IN WITNESS HEREOF, I/We have hereunto set my/our hands,

this day of 2004

MESSE Laurence Josette

this day of 2004

HAYES Barrie James

Signature of witnesses:

I,

whose full post office address is

hereby declare that I was personally present and did see who is/are personally known to be the person(s) named in the above assignment duly sign and execute the same.

This day of 2004

Signature of Witness

I,

whose full post office address is

hereby declare that I was personally present and did see who is/are personally known to be the person(s) named in the above assignment duly sign and execute the same.

This day of 2004

Signature of Witness

Exhibit 3

24 FEB. 2005

Westlands
33, High Street
Little Eversden
Cambs CB3 7HE
England

CC CB
SB

01223 262 558

20.02.05

Dear Ms Essche

Stereo lithography resin stabilisation patent
Your ref. : HAM 830006/WO

As promised I am writing this letter to outline my situation relative to this patent.

As you know I have been asked to sign away any rights I have with respect to the patent applications for the USA and Canada. I think I should now explain my reluctance to do this without any financial consideration in my favour.

- On retirement from Ciba Specialty Chemicals at the standard age I was asked to carry out further work for the Company, which I agreed to do.
- 1) Was the task, controlled by Marketing, of lecturing to engineering undergraduates in universities throughout the UK to promote structural bonding and particularly, of course, the Araldite range. This was very successful and resulted in 2003-4 in 45 lectures to some 5,000 students, all of whom were given specially designed CSC (then Vantico, then Huntsman) literature. Unfortunately Huntsman removed funding for this activity at the end of the 2004 academic year.
- 2) To carry out specifically agreed, recorded, R and D projects under the auspices of the then Research Manager, Dr Klaus Rabener. These went very smoothly and without problems until Dr Rabener returned to Basle.
- After Dr Rabener, Dr Tim Handyside took over this role and, whilst very friendly, was very difficult to meet with and almost impossible to contact by telephone or e-mail – rarely replying to messages etc.
- When I made first contact with him I told him what I had been doing for Dr Rabener. He asked me to continue to work for him, as my only point of contact, but now to teach the significant number of new staff in his department, epoxy chemistry and site history, and if I could, help them with their projects.
- I agreed to do this on the understanding that there would be a written contract to cover this work and a two way secrecy agreement to protect each other's interests so that Vantico secrets were safe and my input could be recognised for personal reward depending on commercial success as well as standard payment by the hour.

- On 30.05.01 I e-mailed Dr Handyside with details of the secrecy agreement I was prepared to work under at that time. The key elements of this are as follows :-

“ Secrecy Agreement”

Between Vantico Ltd and Barrie Hayes, ‘The ‘Parties’, covering information in the form of verbal discussions, reports, written ideas, product profiles etc. ‘The Information’

Both parties undertake as follows:-

- i) To use the ‘The Information’ for the purpose of designing, making, formulating, improving and marketing products for Vantico Ltd.
- ii) Not to make any commercial use of the other ‘Parties’ ‘Information’ without express consent in writing.

I received no reply and e-mailed Dr Handyside again on 02.07.01.

“ I have been thinking about the arrangements we could come to that would be satisfactory for both of us and I think the following would be satisfactory for me, but what about you?”

“ Such an arrangement would enable us to work together under the cover of the proposed secrecy agreement and allow free discussion and assistance on any of your development programmes and allow you to consider any proposals I might have for new and improved products.

Dr Handyside e-mailed me on 14.07.01.

“ It all sounds good to me and a place to start from. Let’s get on with it and see how it goes.”

- On this basis I gave the epoxy chemistry lectures and site history talks as requested and on the 21.09.01 discussed the SLA resin bath stability problems (not my area of knowledge or expertise) with Laurence Courvoisier (now Messe).
- The next thing I heard on this subject was a request to sign patent documents for the filing of this, my idea, which had been diligently pursued and proved by the excellent chemist Laurence.
- All my ideas and assistance to that time had been based on my proposed secrecy agreement and the Dr Handyside e-mailed ‘go ahead’.
- When I next saw him I reminded him of the arrangement but he seemed unaware of any commercial exploitation in relation to this patent or any other ideas I had made. I have not received to this day any request written or otherwise covering commercial exploitation of this, or any other, idea according to the arrangement I was working under, although I understand this invention is now being used widely.

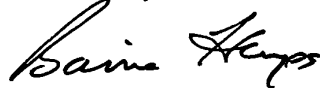
- At that time I read the proposed patent application, made corrections I felt were necessary and pointed out which items covered in the specification would not work, "subsequently found to be the case". I asked for a copy of the final application but never received one. The version I saw contains statements to the effect "Finding a viscosity stabiliser that will capture the acid species created upon ageing without affecting the cure properties of the resin is a real breakthrough" and "Examples 22 and 23 show the remarkable effect of DY 9577 as a viscosity stabiliser".
- As my dear wife was extremely ill at the time and sadly has since died I may not have given this matter enough attention to ensure that my interests were protected but the recent requests to sign these patents have now brought the issue firmly to my attention.

I think it will be clear from the foregoing that I have not been treated correctly, however unintentionally, by Vantico. Had I been consulted at the time by Dr Handyside, as our foregoing agreements require, I would have been able to negotiate a commercial arrangement which would almost certainly have been for a cash payment and a royalty on sales.

I am not a greedy man and was a loyal and effective employee of "Ciba" for 39 years with many major inventions to my name on behalf of the Company. Equally I do not wish to cause major difficulties to Ciba's successors so I suggest that the standard sales value of one tonne of SLA resin containing these stabilisers would be a reasonable and final settlement.

I would be grateful if you could ensure that this letter is directed to the appropriate people in Huntsman.

Yours sincerely

A handwritten signature in cursive script, appearing to read 'Barrie Hayes'.

Barrie Hayes